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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,604	06/15/2000	HIROKAZU TANAKA	1217-001125	9815

7590 02/05/2004  
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EXAMINER

AHMED, SHEEBA

ART UNIT PAPER NUMBER

1773

DATE MAILED: 02/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/581,604

Applicant(s)

TANAKA ET AL.

Examiner

Sheeba Ahmed

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 1-14.Claim(s) withdrawn from consideration: None.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See attached sheet.

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1. The Request for consideration submitted on January 2, 2004 has been entered in the above-identified application however does not place the application in condition for allowance.

Applicants traverse the rejection of claims 1-14 under 35 U.S.C. 103(a) as being unpatentable over Kayanoki (US 5,963,373) and submit that the claimed composite metal oxide exhibits no photochromism and excellent water resistance, properties that not have been suggested by Kayanoki, and that the Applicants claimed range exhibits different properties than the range disclosed by Kayanoki.

The Applicants arguments are not found persuasive. As pointed out previously in the Final rejection mailed on August 27, 2003, Kayanoki specifically disclose fine particles of a composite composed of iron oxide, titanium oxide and a silica component wherein the weight ratio of the iron oxide to the titanium oxide is in the range of **0.005 to 1.0** and the weight ratio of silica to the sum of the iron oxide and titanium oxide is in the range of 0.001 to 1.0. Although, Kayanoki does not specifically disclose that the weight ratio of the iron oxide to the titanium oxide may be 0.0005 to less than 0.005 (*as recited in independent claims 1 and 2*) or 0.001 to 0.0045 (*as recited in dependent claims 13 and 14*), a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). In this case, it would have been obvious to one having ordinary skill in the art to have expected the same properties for a hard coat film comprising composite metal oxide particles of iron oxide and titanium

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oxide wherein the weight ratio of the iron oxide to the titanium oxide is 0.0045 or 0.0045 to less than 0.005. Furthermore, the graphical data relating to Photochromism and Water Resistance given on Pages 3 and 4 of the Request for Reconsideration indicates data points at and beyond 0.005 also show water resistance and no evidence of photochromism and the Applicants state that "composite metal oxides having the limited weight ratio (**0.0005 to 0.005**) of iron oxide to titanium oxide of the present invention is free from photochromism" and hence the Applicants have failed to show that one would **NOT** have expected the same properties for a hard coat film comprising composite metal oxide particles of iron oxide and titanium oxide wherein the weight ratio of the iron oxide to the titanium oxide is 0.0045 or 0.0045 to less than 0.005.

### **Conclusion**

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-1504. The examiner can normally be reached on Mondays and Thursdays from 8am to 6pm.

  
Sheeba Ahmed  
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January 29, 2004

  
Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700